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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,317	12/18/2001	Kiyoshi Kobayashi	9281-4253	1869

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EXAMINER

KIM, PAUL D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/025,317

Applicant(s)

KOBAYASHI, KIYOSHI

Examiner

Paul D Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 1-9 are objected to because of the following informalities:

As per claim 1: The phrase "the width" recited in line 15 should be --a width--.

The phrase "the track" recited in line 17 should be --a track--.

The phrase "the bottom" recited in lines 17-18 should be --a bottom--.

The phrase "the top" recited in line 18 should be --a top--.

The phrase "the backside" recited in lines 19-20 should be --a backside--.

The phrase "the top face" recited in line 23 should be --a top face--.

The phrase "the normal" recited in line 25 should be --a normal--.

As per claims 2-9: The phrase "A method" recited in line 1 should be changed to --The method--.

As per claim 3: The phrase "the patterning precision" recited in line 3 should be --a patterning precision--.

As per claims 4 and 5: The phrase "the range" recited in line 3 should be --a range--.

As per claim 9: Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. There is no step (j) in claim 1. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are numerous phrases and clauses that are naming the claimed invention devices by other descriptive words other than what is used in the disclosure that are vague, indefinite, and/or awkwardly and confusingly worded, and therefore, are not fully understood. Further, it is extremely difficult to decipher and pin point each claimed invention devices with that of the figures and causing confusion (i.e., vague and unclear). The following are examples of such deficiencies:

Re. Claim 1: The phrase "forming a coil layer in a region behind the opposing face" as recited in lines 9-10 renders the claim vague and indefinite. It is unclear as to where the coil layer is formed. Is it located before or after the coupling layer? Or, Is it formed on the auxiliary magnetic pole layer or the coupling layer?

The phrase "depositing an insulating layer on the auxiliary magnetic pole layer and depositing a plating base layer on the insulating layer" as recited in lines 11-13 renders the claim vague and indefinite. It is unclear whether the insulating layer is covered the coil layer or the coupling layer or both the coil layer and the coupling layer or a place of the auxiliary magnetic pole layer not covered both the coil layer and the coupling layer.

The phrase "the groove having a predetermined length from the opposing face toward the backside" as recited in lines 19-20 renders vague and indefinite. It is unclear where the backside is indicated.

The phrase "coupling the main magnetic pole layer with the coupling layer directly or by forming a yoke layer on the coupling layer over the main magnetic pole layer and the coupling layer" as recited in lines 27-30 renders the claim vague and indefinite. If the insulating layer is covered over the coupling layer and the plating base layer is covered the insulating layer, according to the limitation recited in lines 11-13, it is impossible to connect the main magnetic pole layer with the coupling layer either directly or the yoke layer formed over the main magnetic pole layer and the coupling layer. Even though the plating base layer is formed of either magnetic or nonmagnetic materials (as recited in claims 7 and 8), the coupling layer is still covered by the insulating layer.

Although, every applicant is entitled to make up new terminologies, as so desired, please clarify what the deficiencies are so that the examiner can clearly understand and prosecute the merits of the invention by pointing out the claimed devices in the specification and the drawings in the next communication. Applicant's full cooperation will be greatly appreciated.

4. No art rejections have been applied to the claims 1-9, since there are a great deal of confusion and uncertainty as to the proper interpretation of the limitations of

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claims. Therefore, it would not be proper to reject such claims on the basis of prior art. See MPEP 2173.06.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D Kim whose telephone number is 703-308-8356. The examiner can normally be reached on Tuesday-Friday between 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul D Kim  
Examiner  
Art Unit 3729